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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,003	01/18/2002	Patrick C. Marks	9319	7774

7590 04/07/2005  
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EXAMINER

NGUYEN, TU MINH

ART UNIT PAPER NUMBER

3748

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/051,003

Applicant(s)

MARKS ET AL.

Examiner

Tu M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,4 and 7-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,4 and 7-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. In view of an Applicant's Supplemental Paper filed on September 28, 2004 in response to a Remand by the Board of Patent Appeals and Interferences, PROSECUTION IS HEREBY REOPENED. A new non-final rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office Action is non-final) or a reply under 37 CFR 1.113 (if this Office Action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Overall, claims 3, 4, and 7-12 are pending in this application.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3, 4, and 7-12 are rejected under 35 U.S.C. 112, second paragraph, because the base claims 3 and 7 recite the limitation "said means for changing the frequency response"; and base claim 9 recites the limitation "said means for changing the frequency". These limitations

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are not consistent with the limitation “means for attenuating noise” as earlier claimed. As such, applicant should amend the base claims so that the phrase following the word “means” is consistent throughout the base claims.

In addition, based on the Applicant's Supplemental Paper, applicant failed to include the equivalents of the element for the “means plus function” limitation. For example, applicant specified numerals 150-2 and 150-3 for the embodiment of Figures 4-6 in the limitation “said means for changing the frequency”, however, failed to specified the same numerals for the limitation “means for attenuating noise”. Thus, it is impossible for the examiner to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 3, 7, and 9, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Jessberger (U.S. Patent 6,494,290).

Re claim 3, as shown in Figures 2-3, in a system having a multi-speed engine with an air inlet line (1) connected to the engine, Jessberger discloses a Helmholtz resonator structure comprising:

- a closed chamber (9) configured as a single dead end side branch connected to the inlet line and defining a Helmholtz resonator continuously operatively connected to the inlet line via a restricted connection (7) (the restricted connection (7) is always or continuously connected to the closed chamber (emphasis added); the restricted connection (7), even though in only periodic fluid communication with the closed chamber, is always in operation to reduce noise in the air inlet line when the engine is in operation); and

- means (10, 7, 8) for attenuating noise in a plurality of frequencies by changing the frequency response of the Helmholtz resonator responsive to changes in speed of the engine (also see Figures 5 and 6);

wherein the means for attenuating noise includes at least one restricted connection (8) which is selectively connected between the chamber and the inlet line (connection (8) is selectively opened or closed (lines 8-15 of column 3)).

Re claim 7, as shown in Figures 2 and 3, Jessberger discloses a system having a multi-speed engine with an inlet line (1) connected to the engine, microprocessor means (not shown but inherently must have) for controlling the speed of the engine, the improvement comprising:

- a closed chamber (9) configured as a single dead end side branch connected to the inlet line and defining a Helmholtz resonator continuously operatively connected to the inlet line via a

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restricted connection (7) (the restricted connection (7) is always or continuously connected to the closed chamber (emphasis added); the restricted connection (7), even though in only periodic fluid communication with the closed chamber, is always in operation to reduce noise in the air inlet line when the engine is in operation); and

- means (10, 7, 8) for attenuating noise in a plurality of frequencies by changing the frequency response of the Helmholtz resonator responsive to changes in speed of the engine (also see Figures 5 and 6);

wherein the means for attenuating noise includes at least one restricted connection (8) which is selectively connected between the chamber and the inlet line (connection (8) is selectively opened or closed (lines 8-15 of column 3)).

With regard to the preamble directed to "a refrigeration system", a preamble to a claim is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self contained description of the structure not depending for completeness upon the introductory clause. See *Kropa v. Robie, supra at 480*. See also *Ex parte Mott*, 190 USPQ 311, 313 (PTO Bd. of App. 1975). Clearly, the pending base claim 7 does not rely on the preamble for completeness.

Re claim 9, as shown in Figures 2 and 3, Jessberger discloses a system having a multi-speed engine with an inlet line (1) connected to the engine, microprocessor means (not shown but inherently must have) for controlling the speed of the engine, the improvement comprising:

- a closed chamber (9) configured as a single dead end side branch connected to the inlet line and defining a Helmholtz resonator continuously operatively connected to the inlet line via a

restricted connection (7) (the restricted connection (7) is always or continuously connected to the closed chamber (emphasis added); the restricted connection (7), even though in only periodic fluid communication with the closed chamber, is always in operation to reduce noise in the air inlet line when the engine is in operation); and

- means (10, 7, 8) for attenuating noise in a plurality of frequencies by changing the frequency response of the Helmholtz resonator responsive to changes in speed of the engine (also see Figures 5 and 6);

wherein the means for attenuating noise includes a valve (10) having only an open and a closed position (valve (10) is alternately closed and opened (line 13 of column 3)).

With regard to the preamble directed to "a refrigeration system", a preamble to a claim is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self contained description of the structure not depending for completeness upon the introductory clause. See *Kropa v. Robie, supra at 480*. See also *Ex parte Mott*, 190 USPQ 311, 313 (PTO Bd. of App. 1975). Clearly, the pending base claim 9 does not rely on the preamble for completeness.

#### ***Allowable Subject Matter***

6. Claims 4, 8, and 10-12 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims.

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*Communication*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tu Nguyen whose telephone number is (571) 272-4862.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas E. Denion, can be reached on (571) 272-4859. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Tu M. Nguyen*

TMN

Tu M. Nguyen

March 30, 2005

Primary Examiner

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